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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 05725.1227-00000 (Optional)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/617,676	Filed July 14, 2003
First Named Inventor Frédéric LEGRAND		Examiner Hasan S. Ahmed	
Art Unit 1615		Examiner Hasan S. Ahmed	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.

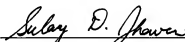
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
 Typed or printed name _____

☒ attorney or agent of record.
 Registration number 65,437

☐ attorney or agent acting under 37 CFR 1.34.
 Registration number if acting under 37 CFR 1.34 _____



 Sulay D. Jhaveri

 (202) 408-4000

 Telephone number

 April 6, 2010

 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief panel review of the rejections set forth in the Final Office Action mailed January 6, 2010. This request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31 and appropriate appeal fee payment. No amendments are being filed herewith.

REMARKS

The arguments raised below are not comprehensive of all the reasons that Applicant has in traversing the rejections in the Final Office Action, but represent a summary of the prosecution history, which Applicant specifically incorporates by reference herein. Applicant reserves the right to raise additional arguments on appeal, including arguments not raised here.

I. Status Of The Claims

Claims 1-32 are pending. Claims 1-22 remain rejected. Claims 23-32 have been withdrawn from consideration by the Examiner as being directed to non-elected subject matter. No amendments have been made in this response.

II. The rejection of claims 1-22 under 35 U.S.C. § 103(a) is improper.

The Examiner rejects claims 1-22 under 35 U.S.C. § 103(a) as allegedly "being unpatentable" over U.S. Patent No. 6,540,791 to Dias ("Dias"), in view of U.S. Patent No. 6,260,556 to Legrand et al. ("Legrand"), further in view of U.S. Patent No. 6,423,306 to Caes et al. ("Caes"), and further in view of U.S. Patent No. 6,423,306 to Starch

("Starch"). Final Office Action, page 2. The Examiner contends that Dias teaches a hair bleaching composition comprising polydecene, nonionic amphiphilic polymers, peroxygenated salt, an alkaline agent, and surfactants as recited in the rejected claims. See *id.*. The Examiner relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents that are not disclosed in Dias. See *id.*, at pages 3-4. The Examiner states that "[Dias] differs from the instant application in that it does not disclose" the claimed polydecene. *Id.*, at page 4. The Examiner relies on Starch for support that "the use of polydecene compounds of up to 40 carbons in cosmetic formulations was known in the art at the time the instant application was filed[.]" *Id.* The Examiner concludes that it would have been obvious for a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by Dias, in view of Legrand, further in view of Caes, further in view of Starch. *Id.*, at page 5. Applicant respectfully disagrees for at least the following reasons.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. 148 U.S.P.Q.

at 467. "Such evidence . . . may include evidence of . . . unexpected results." M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; see also *KSR*, 82 U.S.P.Q. 2d at 1388.

Dias discloses polydecene amongst a long list of organic conditioning oils, including paraffin oil, mineral oil and fatty acid esters such as isopropyl myristate and isopropyl palmitate. See Dias Col. 22, line 42 - Col. 25, line 15. Moreover, Dias provides nine examples of alkaline hair bleaching compositions; but none of those examples includes polydecene. Without the disclosure of the present invention, the Examiner has failed to point to any evidence to pick and choose polydecene from the long list of the organic conditioning oils disclosed in Dias as the lead compound in support of the obviousness rejection.

Further, the Examiner bases the obviousness rejection on the erroneous assumption that "a person of ordinary skill in the art would be motivated to use hydrocarbon polymers having more than 19 carbon atoms, including those claimed, and would expect such a composition to have similar properties to those claimed[.]" See Final Office Action, page 4. This assumption is incorrect for at least the following reasons.

First, the instant specification discloses the drawbacks of using mineral oil and long chain hydrophobic fatty acid esters. See specification, as filed, at ¶¶ [010]-[013]. Second, the test results in the Declaration under 37 C.F.R. § 1.132 of Florence Laurent ("Declaration") demonstrate that compositions containing other organic conditioning oils could not provide the advantageous properties of compositions with polydecene. The

paste formulated with polydecene remains malleable at low temperature, whereas the comparative compositions with Vaseline, isopropyl palmitate, and isopropyl myristate, were solid and brittle. See Declaration, page 4. Taken together, the disclosure in the specification and the test results in the Declaration demonstrate that it is not predictable whether the choice of any one of the conditioning oils from the long list of the organic conditioning oils disclosed in Dias would lead to the desirable properties achieved by the claimed composition. The combination of Dias with Caes, Legrand and Starch does not cure this fatal flaw. Thus, the Examiner cannot factually support a *prima facie* case of obviousness. Accordingly, this rejection is improper.

In view of the foregoing, Applicant respectfully requests that the Panel withdraw the outstanding rejection for at least the reasons stated above. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 6, 2010

By: Sulay D. Jhaveri
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